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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,733	10/15/2003	Robert Grzesek	MAT 314	1775
23581	7590	03/13/2006	EXAMINER	
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			MILLER, BENA B	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,733

Applicant(s)

GRZESEK ET AL.

Examiner

Bena Miller

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-11, 13-15, 17, 18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-11, 13-15, 17, 18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

*Bena B. Miller*

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11, 13-15 and 17 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 11, the subject matter, "magnetically coupled to at least one of the second and third.....in a direction non-parallel to an axis of rotation of the first component", is not supported by the original specification and therefore, now constitute New Matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13-15 and 17 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, it is not clear if the first component is "magnetically coupled to at least one of the second and third.....in a direction non-parallel to an axis of rotation of the first component".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7 and 10 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Alonso (US Patent 3,375,604).

The device of Alonso reads on the structural limitations of the claims including a first component (106 and 110; it should be noted that the elements 110 and 106 is spaced away from magnet portion 112 as seen in figure 7), second component (116), magnetic portion (112; it should be noted that element 112 is affixed to first component 110 via 106 and 108), an alignment assembly (108) and a third component (122).

Claims 1-3, 7-10 and 25 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Dasher (US Patent 2,791,867).

The device of Dasher reads on the structural limitations of the claims including a first component (2), second component (3), magnetic portion (30 mounted in opening 21), an alignment assembly (post 13 and opening 21) and a third component (8; fig 1 and 9).

Claims 11, 13-15 and 17 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Salosky (US Patent 2,803,920).

The device of Salosky reads on the structural limitations of the claims including a first component (the shaft which holds wheel 13—fig. 2), second component (12) and third component (15) magnetically couple with one another (fig. 3), and an alignment

Art Unit: 3725

assembly (16 and 23'). It should be noted that the Examiner takes the position that the first component is magnetically coupled to the at least third component (15) via extend magnet 20 of second component 12 in a direction non-parallel to an axis of rotation of the first component.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-14, 15, 17, 18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (US Patent 2,587,142) in view of Salosky (US Patent 2,803,920) or Sims et al (US Patent 4,176,492).

Gray teaches in the figures most of the element of the claimed elements including post (46b). However, Gray fails to teach a magnetic portion affixed to the components. Salosky teaches a toy vehicle having parts attached to one another by a magnet (col. 1, lines 49-72). Sims teaches articulated magnetized toy that can be configured to represent a vehicle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate magnets as taught by Salosky or Sims to the toy of Gray for the purpose of movably retaining the components of the toy. Further, that the first component of Gray is coupled to one of the second and third component in a direction non-parallel to an axis rotation of the first component and would have been obvious to one having ordinary skill in the art to use a magnet portion

Art Unit: 3725

as suggested by Salosky or Sims to couple the first component of Gray to one of the second and third components as noted above.

Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Dasher (US Patent 2,791,867).

Dasher teaches in the figures most of the element of the claimed elements except a light. It is well known in the prior art to provide toys with light. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a light in the device of Dasher for the purpose of creating amusement when playing with the toy.

### ***Response to Arguments***

Applicant's arguments filed 11/25/05 have been fully considered but they are not persuasive. In response to Applicant's remarks that Alonso fails to disclose or suggest an alignment assembly spaced away from the magnetic portion, Applicant's attention is directed above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gray teaches a car that uses securing means to connected components of the car. Salosky and Sims

Art Unit: 3725

that it is known to magnetically couple a toy car components. Therefore, the combination prior would have been obvious to one of ordinary skill in the art to meet the claimed elements.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

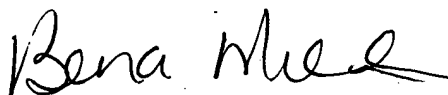
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bena Miller  
Primary Examiner  
Art Unit 3725

bbm  
March 06, 2006